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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,424	12/12/2001	John J. Hart III	ECD-0004	2326
7590 03/01/2006			EXAMINER	
MILLS & ONELLO LLP			DINH, TAN X	
Suite 605			ART UNIT	
Eleven Beacon Street			PAPER NUMBER	
Boston, MA 02108			2653	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/023,424	HART ET AL.	
	Examiner	Art Unit	
	TAN X. DINH	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,23-38 and 50-55 is/are rejected.
- 7) ☒ Claim(s) 11-22 and 39-49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1) A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under Ex Parte Quayle, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicants submission filed on 12/09/2005 has been entered.

2) The I.D.S filed 12/09/2005 has been considered by the Examiner. However, the US applications S/N 09/608,886, filed on 6/30/2000 and 09/631,505, filed on 8/03/2000 are not consider since these application have not been publication.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

4) (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5) Claims 1,2,7,8,9,10,23-27,29,30,35,36,37, 38,50-54 are rejected under 35 U.S.C. 102(anticipated) as being anticipated by SELINFREUND et al (US 2005/0050343).

SELINFREUND et al discloses a method for modifying an optical path of an optical medium as claimed in claims 1 and 2, comprising the step of:

selecting a region of the first layer to be distorted (Fig.2, region 21); and

prior to a reading operation of the medium, distorting the region of the first layer such that a reading operation of data stored in the first data layer corresponding to the distorted region is modified, the distorted region extending in a direction along a track of the data layer, the distorted region maintaining its optical characteristics following irradiation of the distorted region during the reading operation (Fig.2, the region 21 is attached to medium 20 during manufacturing and prior to a reading operation of the medium distorted a region 21 (tracks a,b,c and d) as seen in figure 3, and maintaining its optical characteristics following irradiation of the distorted region during the reading operation).

The medium claims 29 and 30 are drawn to the medium corresponding to the method of using same as claimed in claims 1 and

2. Therefore, medium claims 29 and 30 are rejected for the same reasons of anticipation (obviousness) as used above.

As to claims 7-10 and 35-38, SELINFREUND et al shows the distorted region is provide at a predetermined location for modifying the reading (Fig.2, region 21 and Fig.3, region 21).

As to claims 23,24,50 and 51, SELINFREUND et al shows distorting region comprises altering surface of the first layer (Fig.2, distorted region 21).

As to claims 25,26,52 and 53, SELINFREUND et al shows the distorted region is formed during manufacturing or following manufacturing the optical medium (paragraph [0037]).

As to claims 27 and 54, SELINFREUND et al shows distorting is conducted by a distorting technique selected from the group of pressure, heat, chemical, electrical, friction (paragraph [0011] to [0017]).

6) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8) Claims 3-6, 28, 31-34 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over SELINFREUND et al (US 2005/0050343).

SELINFREUND et al discloses all the subject matter as claimed in claims 3-6 and 31-34, except to specifically show a back layer and a reading layer. Official Notice is taken that back layer and reading layer are widely used in the art for reading and labeling the optical disc, and therefore they are old and well known. It would have been obvious to use the old and well known back layer and reading layer in an optical disk such as SELINFREUND et al's because, in the absence of any new or unexpected result, selecting of a known material/element based on its suitability for the intended use is deemed obvious. In re LESHIN, 125 USPQ 416.

As to claims 28 and 55, the dual-sided optical recording disc are old and widely used in the optical recording art.

9) Claims 11-22 and 39-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(see form PTO-892 attached herein).

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts) the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made.

Applicant *must also show how the amendments avoid such references and objections*. See 37 CFR § 1.111(c).

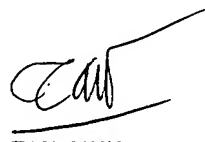
11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN Xuan DINH whose telephone number is (571) 727-7586. The examiner can normally be reached on MONDAY to FRIDAY from 8:00AM to 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from

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either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

February 24, 2006